

REMARKS

Claims 1-16 are pending in this Application. As claims 13-16 continue to not be rejected over the prior art, Applicant respectfully assumes that these claims remain allowable. Applicant respectfully thanks the Examiner for indicating this allowable subject matter.

Rejections under 35 U.S.C. §112, first and second paragraph

Claims 1-16 are rejected under 35 U.S.C. §112, first and second paragraph for allegedly being non-compliant with the written description requirement and indefinite. Applicant respectfully disagrees with these rejections. The portion in question of Applicant's claim recites *inter alia*:

“the shutter being pressed against a surface of the slide at an area where a lateral extent of the shutter crosses and overlaps with an extent of at least one of the two vertical slides.”

Applicant respectfully asserts that basis for this limitation can be found at at least page 8, lines 31-36 and Figure 5 of the Specification, wherein the shutter 4 is clearly stated and shown to press against an external or outer face of the external flange 28, wherein Figure 5 clearly shows the left end of the shutter 4 to overlap a right hand extent of the flange 28, which is part of the vertical slide 2.

It is in this “area” directly above 28 that the above limitation occurs. Accordingly, Applicant respectfully asserts that the 112 first and second paragraph rejections are improper. However, Applicant would of course be willing to discuss with the Examiner any non-limiting amendments to the claims that might render the claims more acceptable to the Examiner.

Rejections under 35 U.S.C. §102(b) and 103(a)

Claims 1-2, 6, 8, and 9 have been rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,938,273 to Dubbelman (“Dubbelman” hereinafter). Claims 4, 5, 7, and 10-12 have also been rejected under 35 U.S.C. §103(a) as being obvious over Dubbelman in view of United States Patent No. 5,056,579 to Krafutler (“Krafutler” hereinafter). Applicant respectfully

traverses these rejections.

Applicant respectfully notes that the 102 and 103 rejections are no more than a reiteration of the rejections made in the previous Office Action mailed March 4, 2008. Accordingly, these rejections do NOT address “the shutter being pressed against a surface of the slide at an area where a lateral extent of the shutter crosses and overlaps with an extent of at least one of the two vertical slides,” which was amended into claim 1 in Response to the previous Office Action mailed March 4, 2008. Applicant respectfully points out that submittal of a Final Office Action without considering the above quoted element is improper.

According to MPEP 2143.03, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”

In addition, under MPEP2143.03 I,

“>I. < INDEFINITE LIMITATIONS MUST BE CONSIDERED

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984),” (emphasis added), and

under MPEP2143.03 II,

“>II. < LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED

When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims

must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984)” (emphasis again added).

Thus, according to MPEP 2143.03, an Office Action should not have been issued without evaluating all elements of the claims over the prior art, including the newly added element, “the shutter being pressed against a surface of the slide at an area where a lateral extent of the shutter crosses and overlaps with an extent of at least one of the two vertical slides.” Further, as is stated in MPEP 2143.03 I and II, the 112 rejections (whether proper or not) do not alleviate the requirement of such an evaluation.

Accordingly, under MPEP 706.07(c-d) and 37 C.F.R. 1.181, Applicant respectfully petitions for withdrawal of finality status of the rejections. Applicant respectfully requests either a Notice of Allowance based on the above quoted amendment submitted in Response to the Office action mailed March 4, 2008, a new Office Action setting forth allowability of the claims pending 112 issues, or a new Office Action setting forth prior art rejections directed to the above quoted element of the claims.

Hereinbelow and for the Examiner’s convenience, Applicant respectfully re-submits arguments directed to overcoming the previously cited art based on the above quoted claim element.

Rejections under 35 U.S.C. §102(b)

Claims 1-2, 6, 8, and 9 have been rejected under 35 U.S.C. §102(b) as being anticipated by Dubbelman.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant’s amended claim 1 recites, *inter alia*:

“wherein the shutter presses against and overlaps an outer face of a flange extending from each of the slides, the outer face running substantially parallel to a lateral surface of the shutter.”

Dubbelman does not teach a lateral extent of a shutter that presses against and overlaps an outer face of a flange extending each of two slides, wherein the outer face runs substantially parallel to a lateral surface of the shutter. On the contrary, referring to Figures 3, 5, and 7, Dubbelman teaches a door leaf 1 that is flush with the rail 9 (please see the cross sectional view in Figure 3 in particular). The door leaf 1 includes stiffened panels that alternate with fully flexible panels, and are provided with guide rollers 15 that are engaged in three parallel chambers of the rail 9. Accordingly, because each of the guide rollers 15 are engaged in the three parallel chambers of the rail 9, the leaf 1 could not be positioned in any way but flush against the rail 9 as shown in Figure 3. As such, the leaf 1, or any flange portion thereof, does not and cannot overlap with the rail 9, as recited in Applicant’s amended claim 1.

For at least these above reasons, Applicant respectfully submits that Dubbelman does not teach every element of Applicant’s claim 1, or claims 2, 6, 8, and 9 that depend respectfully therefrom. Therefore, it is respectfully asserts that claim 1, 2, 6, 8, and 9 are not anticipated by Dubbelman.

Rejections under 35 U.S.C. §103(a)

Claims 4, 5, 7, and 10-12 have been rejected under 35 U.S.C. §103(a) as being obvious over Dubbelman in view Krafutler. Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 4, 5, 7, and 10-12 depend from claim 1. As such, for at least the reasons discussed in the above 102 rejection, Applicant respectfully asserts that Dubbelman does not teach every element of Applicant's claims 4, 5, 7, and 10-12. Since Krafutler does not remedy the deficiencies of Dubbelman, Applicant further asserts that the proposed combination of Dubbelman and Krafutler does not teach every element of Applicant's claims 4, 5, 7, and 10-12. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 4, 5, 7, and 10-12 with respect to the proposed combination Dubbelman and Krafutler. Since the proposed combination of Dubbelman and Krafutler fails to teach or suggest all of the limitations of claims 4, 5, 7, and 10-12, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the references, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Conclusion

Applicant believes that all of the outstanding objections and rejections have been addressed herein and are now overcome. Entry and consideration hereof and issuance of a Notice of Allowance are respectfully requested.

Applicant hereby petitions for any extension of time under 37 C.F.R. 1.136(a) or 1.136(b) that may be necessary for entry and consideration of the present Reply.

If there are any charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

The Office is invited to contact applicant's attorneys at the below-listed telephone number concerning this Amendment or otherwise regarding the present application.

Respectfully submitted,
CANTOR COLBURN LLP

By: /Daniel R. Gibson/
Daniel R. Gibson
Registration No. 56,539
CANTOR COLBURN LLP
20 Church Street
22nd Floor
Hartford, CT 06103
Telephone: 860-286-2929
Facsimile: 860-286-0115
Customer No. 23413

Date: April 2, 2009